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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,413	09/03/2003	Charles D. Morris	15047US01	5462

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EXAMINER
JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
1773	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/654,413	MORRIS ET AL.	
	Examiner	Art Unit	
	Monique R. Jackson	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,19-23 and 37-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19-23 and 37-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's arguments filed 7/19/06 with respect to the election requirement are persuasive. The election requirement is hereby withdrawn. Claims 1-17, 19-23, and 37-44 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-17, 19-23, and 37-44 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. An impact dampening layer of unbound rubber, thermoplastic elastomer or other impact dampening particulate is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The instantly claimed invention of Claims 1-17, 19-23, and 38-44 only requires a particulate layer, in general, and does not recite that the particulate layer is an impact dampening layer formed from rubber, elastomer or other impact dampening particulate, which according to the Background of the Invention as well as the Summary of the Invention appears to be essential to the invention. On the other hand, the invention of Claim 37 fails to include a particulate layer at all, which once again appears to be essential to the invention. Further, considering the instant disclosure at the time of filing does not provide a definition of the term "particulate" to limit it to only rubber, elastomer or other

impact dampening materials, the invention as claimed encompasses particulate material that is outside the invention, namely rough or hard particulate material.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 14 recite the limitation "wherein the depth of said particulate layer is adjusted to achieve a desired impact resistance", however considering the claims are directed to a product and not a process, it is unclear how the depth "is adjusted" or what exactly is meant by the term "is adjusted".

6. Claims 6, 9, 17, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 9 recite the limitation "said particulate" in line 1, however considering the claims depend upon Claim 5 which introduces a "second" particulate, it is unclear to which particulate Claims 6 and 9 refer. Hence, there is insufficient antecedent basis for this limitation in the claims. Similarly, Claims 17 and 20 recite the limitation "said particulate" and depend upon Claim 16 which introduces a "second particulate" and hence there is insufficient antecedent basis for this limitation in the claims.

7. Claim 10 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 21 recite the limitation "said surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "said coarse particulate layer" in 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 7-8, 10, 11, 12, 14, 15, 19, 21, 22, 23, 38, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Unterstenhoefer et al (USPN 3,446,122.) Unterstenhoefer et al teach an elastic surface for sportgrounds, playgrounds and other recreational activities wherein the surface comprises a water-permeable flexible top covering layer, a bottom filter layer such as gravel, sand or the like, and an intermediate water-permeable elastic layer disposed over said filter layer and formed from particles of expanded plastic (Abstract; Claim 1; Col. 1, lines 62-70.) Unterstenhoefer et al teach that the elastic layers should advantageously be 3 to 15cm in thickness (Col. 2, lines 42-45) and that footpaths and sportgrounds whose covering layer is formed by a lawn are advantageously provided with a subbase of plastic particles (Col. 2, lines 53-55.) Unterstenhoefer et al teach that other covering layers include artificial layers like tennis courts, or covering layers of broken stone or stone chippings (Col. 2, lines 65-Col. 3, lines 5.) Unterstenhoefer et al teach specific examples that read upon the claimed invention wherein the elastic surface may be embedded in a trough and the upper layers of the surface bound by

concrete tiles at edges of the trough to provide a boundary, as well as an examples utilizing multiple particulate layers that read upon the claimed different particle sizes (Examples; Figures 1-7; particularly Examples 5-7.)

11. Claims 1-4, 7-8, 10-15, 19, 21-23, and 38-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Thelen et al (USPN 4,564,310.) Thelen et al teach a resilient paving composition for playfields, sports fields and recreation areas wherein the paving system comprises (1) a soil-covering layer consisting of mineral aggregate spread over a draining soil, (2) a layer of fibrous vulcanized rubber particles covering (1), (3) a core composition layer covering (2) consisting essentially of a matrix formed from vulcanized rubber fibers bonded with rubber latex, and (4) a topping layer covering (3) consisting of vulcanized small rubber particles from about 12-30 mesh, zinc oxide and rubber latex (Abstract; Col. 2; Col. 4, lines 1-2.) Thelen et al teach that the base of mineral aggregate is preferably crushed stone in the size range of ¼ to ½ inch, and that the layer 2 of coarse rubber fibers may be formed from shredded tires, particularly fibrous buffings retained on a 4 to 8 mess screen (Col. 2, lines 50-67.) Thelen et al teach that the playground surface can be installed on the ground under swings or other playground equipment wherein the area is enclosed by a wooden border or concrete curb (Examples.) Thelen et al further teach that in lieu of the topping layer above, the core may be covered with carpet, linoleum, artificial turf, etc (Col. 4, lines 20-25.)

Claim Rejections - 35 USC § 103

12. Claims 5-6, 9, 16-17, 20, 37 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thelen et al. The teachings of Thelen et al are discussed above. Though Thelen et al teach that artificial turf may be utilized in place of the upper rubber particulate layer,

the use of both or a combination of the artificial turf and rubber particles, such as an artificial turf and rubber particulate dispersed within the artificial turf as instantly claimed would have been obvious to one having ordinary skill in the art at the time of the invention. Further, considering Thelen et al teach that the surfacing system may be provided under playground equipment such as swings, and that the thickness of the layers may vary, one having ordinary skill in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum impact resistance to provide at desired locations around the playground equipment based on the use and anticipated traffic on those areas.

Response to Arguments

13. Applicant's arguments filed 7/19/06 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monique R. Jackson
Primary Examiner
Technology Center 1700
January 22, 2007